

No. 944

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IN THE  
UNITED STATES CIRCUIT COURT OF APPEALS  
FOR THE NINTH CIRCUIT.

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J. M. K. LETSON AND F. W.  
BURPEE,

*Appellants and Petitioners,*

vs.

THE ALASKA PACKERS'  
ASSOCIATION,

*Appellee,*

THE ALASKA PACKERS'  
ASSOCIATION,

*Appellant,*

vs.

J. M. K. LETSON AND F. W.  
BURPEE,

*Appellees and Petitioners.*

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**Petition for a Rehearing of the Appellants  
J. M. K. Letson and F. W. Burpee.**

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M. A. WHEATON,  
I. M. KALLOCH,  
*Counsel for Appellants.*

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BURPEE,

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**Petition for a Rehearing of the Appellants  
J. M. K. Letson and F. W. Burpee.**

The appellants herein, J. M. K. Letson and F. W. Burpee, now come and respectfully petition this Honorable Court to grant a rehearing in this case, and they

especially ask for a rehearing as to claims No. 3 and No. 11 of the Jensen patent, upon which this action is based.

The issue in this case is upon the question of infringement and it is this question alone that we shall present in this petition.

The Alaska Packers' Association has brought this suit alleging infringement of six claims out of the sixteen claims of its letters patent No. 376,804, dated January 24, 1888, and issued to Mathias Jensen for an improvement in can capping machines. The complainant and appellee asserts the infringement of claims 1, 3, 5, 9, 10 and 11 of said patent. The Circuit Court decided that claims No. 5, 9 and 10 were infringed, by the defendants, and that the other claims were not infringed.

The machine made by the appellants, and which is asserted by the appellees to contain the alleged infringing combinations, was made according to the description contained in the patent granted by the U. S. Government to the appellants No. 629,574, bearing date July 25, 1899, more than 11 years after the issuance of appellees' said patent.

We have believed for many years last past that the method adopted by this Court, and also the Circuit Court of this circuit, for ascertaining the proper construction to be given to patent claims, and also the extent to which patent claims should be made to reach out and cover other machines than those described in the patent, was at variance with the decisions of the U. S. Supreme Court and with the U. S. courts generally throughout the East. That our contentions in this regard have been correct

we think is shown by the recent decision of the U. S. Supreme Court in the case of *Cramer vs. Singer Manufacturing Co.* In this Cramer case the Circuit Court here decided there was an infringement. The Singer Mfg. Co. appealed the case to this Court and this Court affirmed the judgment, its decision being reported in 109 Fed. Rep. 652.

The Singer Co., however, succeeded in obtaining a writ of certiorari from the U. S. Supreme Court, and the case was taken to, and decided by, that high tribunal. The case was only decided on the first day of last February, and we believe it is not yet reported in the official reports of the Supreme Court. The decision is, however, reported in Vol. 108 of the U. S. Patent Office Official Gazette, at page 1870. The Supreme Court reversed the decision of this Court of Appeals, and also the judgment of the Circuit Court. The mandate of the Supreme Court is now on file in this Court.

This Cramer case was a suit at law, and on the trial thereof, when the evidence was all in, the defendant moved the Court to instruct the jury to bring in a verdict for the defendant, upon the ground that there was no infringement shown, and the Supreme Court decided that this instruction should have been given.

We think the decision of the Supreme Court in the Cramer case is particularly applicable to the case at bar. In the Cramer case the machine which was alleged to contain the infringing combination, and which this Court and the Circuit Court decided did contain it, was made in accordance with letters patent No. 306,469, bearing date

October 14, 1884, and granted to Phillip Diehl for a sewing machine stand and treadle. In that case the alleged infringing machine was invented long after Cramer had made his invention. In the case at bar the alleged infringing machine of Letson & Burpee was also invented long after the Cramer patent was granted. In this respect the two cases are parallel.

In the case at bar the question decided by the Circuit Court and by this Court was upon the issue of invention, both courts holding that Letson & Burpee machine was an infringement of the Jensen patent.

In the Cramer case the Supreme Court decided the case upon the issue of infringement alone.

In the Cramer cases what the defendants manufactured, that was held to be an infringement, was not what was described or claimed in the Cramer patent, but the decisions of infringement were reached only by an application of the doctrine of mechanical equivalents, both by the Circuit Court and by this Court of Appeals.

In the case at bar the defendants did not make or use the mechanism that was described and claimed in the Jensen patent, but the Jensen patent was made to reach out and cover the Letson & Burpee machine only by means of an application of the doctrine of mechanical equivalents.

With all these similarities between the two cases, we think that the decision of the Supreme Court in the Cramer case is especially in point and applicable to the decision of the Circuit Court and of this Court in the case at bar.

Of course there can be no question but that the decision of the Supreme Court did decide upon the identical issue of infringement which was decided by the Circuit Court, and also by this Court in their ruling and holding that the defendant in the Cramer case was not entitled to have the jury instructed to bring in a verdict for the defendant upon the ground that no infringement whatever had been shown. That exact question was decided by the Circuit Court and by this Court and by the Supreme Court, all of the decisions being made in that one identical case, and the decision of the Supreme Court being a direct review of the decisions of the Circuit Court and of this Court.

With this decision of the Cramer and Singer Mfg. Co. case in our favor we will approach the discussion of this petition for a rehearing with courage and an expectant hope that it will be granted. We shall endeavor to present the subject in such a way as to convince the Court that its past methods of construing patents so as to extend claims and make them cover subsequent inventions, which were not made by the patentee who obtained the patents sued upon, will be substantially changed.

Take for instance the said Cramer case to illustrate the need of making such a change in order that equal and exact justice may be done by the Courts, and each inventor protected in his patented invention to the full extent of such invention.

In the Cramer case the Diehl patent covered a new invention which was not described in the Cramer patent nor covered by the language of its claims. It was a new

and useful invention and went into very extensive use in the machines that were made and sold by the Singer Co. Cramer's invention, however, as it was described in his patent, and manufactured by him, never did go into any extensive use. Experience proved that it was not as desirable as other methods already in use in other machines and consequently it never drove any of the other machines out of the market. The Cramer patent expired by its own limitation in January, in the year 1900. It has therefore been open to the public to use for more than four years last past, yet we can learn of no instance in which it has ever been applied to use in any sewing machine since the patent expired. While it would operate mechanically it was not as good as other devices in use in the frames and treadles of sewing machines, and consequently, like the great mass of patents that are issued by the patent office, it never had any intrinsic commercial value. Yet a judgment was entered in Cramer's favor for over \$12,000 damages on account of the use by the Singer Co. of the Diehl patented combination. This amount was for damages alleged to have resulted from the use of the Diehl machine in the Northern District of California alone. Several other suits in other districts were brought on the Cramer patent, but none of them have so far been tried. If the Supreme Court had not come to the rescue of the Singer Co. the amount of damages which would have been recovered by Cramer on account of the use by the Singer Co. of the Diehl mechanism would probably have been something frightful to contemplate. This looks worse when we remember that no one but Cramer ever made or sold his patented device,



and even he abandoned it before he had succeeded in selling fifty of them. This was shown by the evidence at the trial, and not contradicted.

We are not intending to make any captious use of the decision of the Supreme Court in the Cramer case, but are using it to show that some, at least, of the decisions of this Court made in construing patents and in the extension of patent claims, so as to make them cover later inventions, never made by the owner of the patent sued on, and not covered by the language of the claims of his patent, must necessarily result in giving to one man the property of another and must be doing great injustice. We assert that the true rule is to give to every inventor his own invention, and we are intending to make herein an earnest appeal to the Court to adopt this principle, and to give to every inventor his actual invention as made and claimed, and no more. We believe and assert, that by so doing the Court will be doing exact justice to all the patent litigants that come before it, and will be administering the law just as it exists. We have many times heretofore complained of plaintiff's actions in patent cases in leaving the patent sued upon, when he comes to taking his testimony, and often leaving his invention described in the patent sued upon, and which may have had no intrinsic value at all, and shifting his patent over on to the defendants' later invention which had proved to be valuable. Suits are seldom brought against late inventions and patents which have not proved to be valuable. We do not believe that one patent in fifty of the great mass of patents which are issued by the U. S.

Government ever has any commercial value, for the reason that what they cover are not as useful or desirable as other things already in use.

We believe that if the Court here in the trying of patent cases, would adopt the practical rule of ascertaining just where each patented invention commences and ends and then giving to each patentee his actual invention, that its decisions would then be in harmony with the decisions of the U. S. Supreme Court and of the Eastern courts generally, and do equal and exact justice to all.

It is often said that the specifications and drawings of a patent should be liberally construed. With this principle we fully agree; but the specification and drawings of a patent are liberally construed for the one and single purpose and object of making those specifications, if possible, cover the whole of the patentee's invention. It is often the case that specifications are carelessly drawn and do not by their terms or language contain a full description of the invention, and the courts therefore believe, and hold, that no nice strictness of construction should be given to the language of the description and claims of a patent, that may prevent them from reaching to the limitations of the invention and covering the whole of it. This rule of construction we have always believed in, and we believe in it now. Like all the rules of patent law for which we contend, such rule of construction tends to the doing of exact justice in giving to an inventor what actually and rightfully belongs to him.

Such rule of construction, however, never carries the description and claims of a patent beyond the patentee's own invention. Only the *language* of the specification and claims are made broad enough, whether by construction or otherwise, to cover and protect the patentee's actual invention, and they are never to be extended any farther, since if they are, they go beyond the protection of the patentee in his own invention and patent to assist him in plundering, either from the public or from other inventors, things which he was not the inventor of and had no right to claim.

It is sometimes the case that a *liberal* construction of the specifications and claims of a patent consists in giving to the language thereof the very narrowest construction and narrowest meanings that can be extracted from them. This happens when the invention is a thin one, and the language of the specifications and claims of a patent are so broad and general that they would plainly cover things in prior public use that were public property, or the prior inventions of others and would therefore render the whole patent entirely void. Another instance as stated in Sec. 183 of Walker on Patents, which says:

“Claims which are functional in form; that is to say  
 “claims which literally purport to cover a result rather  
 “than a process or a thing, are properly construed to  
 “cover only the process or the thing which produces that  
 “result, for otherwise such claims would be void.” Citing  
*Fuller vs. Yentzer*, 94 U. S. 288, and several other cases.

The foregoing are instances in which the very narrowest construction of the language of the specification and

claims becomes a liberal construction thereof for the reason that it saves to the patentee so much of the patented invention as belongs to him instead of compelling him to lose the whole of what the patent covers.

### MECHANICAL EQUIVALENTS.

But what after all is the ultimate result, and the limit thereof, to which a broad construction and interpretation is given to the specification and claims of a patent? What is the extent to which such construction and interpretation may lawfully go and what are the boundaries which stop it from going farther, and limits its application in particular cases?

We have had an intimate acquaintance with the practice of the patent law as well as an intimate knowledge of the decisions of the courts in construing, applying and administering such law for some 35 years last past, and believe that we understand all of these questions fully and thoroughly.

We assert that the extent to which liberality goes in the construction of a patent simply determines the extent to which the patentee may cover by his patented claims what are known in law as mechanical equivalents.

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Liberality in the construction of combination claims never goes farther than to allow the patentee to cover with his patent claims, to a greater or less extent, mechanical equivalents for each of the mechanical elements of the combination which his claims cover. We are not now speaking of entirely new machines where the patents

cover the machines as a whole. The great mass of contention in patent litigation is over the inventions which are covered by combination claims only.

Again we state that equal and exact justice to all requires the Court to give to a patent and its claims just such a construction as can be done within the terms of their language and give to each patentee just what he has invented, no more and no less.

Now the extent to which the combination claim of a patentee may be allowed to cover mechanical equivalents depends entirely upon the extent of his invention, and particularly to the extent to which he has introduced into it new mechanical operations or actions that produce novel results that were new to the world. There is an immense difference in the nature and quality of patented inventions. For instance, the decision of the Supreme Court says in this identical Cramer case, quoting from one of its former decisions made in the case of *Westinghouse vs. Boyden Power Brake Co.*, 170 U. S. 537, page 561,

“To what liberality of construction these claims are  
 “entitled depends to a certain extent upon the character  
 “of the invention, and whether it is what is termed in or-  
 “dinary parlance a ‘pioneer.’ This word, although used  
 “somewhat loosely, is commonly understood to denote a  
 “patent *covering a function never before performed*,  
 “a wholly novel device, or one of such novelty and im-  
 “portance as to mark a distinct step in the progress of  
 “art, as distinguished from a mere improvement or per-

“fection of what had gone before. Most conspicuous  
 “examples of such patents are: The one to Howe of the  
 “sewing machine; to Morse of the electrical telegraph;  
 “and to Bell of the telephone. The record in this case  
 “would indicate that the same honorable appellation  
 “might be safely bestowed upon the original air-brake  
 “of Westinghouse, and, perhaps, also, upon his auto-  
 “matic brake. In view of the fact that the invention in  
 “this case was never put into successful operation, and  
 “was to a limited extent anticipated by the Boyden pat-  
 “ent of 1883, it is perhaps an unwarrantable extension of  
 “the term to speak of it as a ‘pioneer,’ although the prin-  
 “ciple involved subsequently and through improvements  
 “upon this invention became one of great value to the  
 “public.”

Now it is evident that in such instances as that of Howe sewing-machine and others which the Supreme Court mentions as pioneer inventions there *was an original conception of the possibility of producing a certain result which conception was itself new to the world* and was the foundation upon which he built his machine. Everything, from the ultimate effect of sewing any kind of a continuous seam by any kind of a sewing-machine, and the action of the smallest and least important device in the whole machine, was absolutely new and novel with Howe. The whole principle of the mechanical action of the machine as a whole and of every moving device in the machine was all of Howe's invention, discovery and accomplishment.

It is this class of inventions that the Supreme Court in its said quotations calls the pioneer inventions. Number-

less were the various new inventions upon sewing-machines that were made after Howe had made the first sewing-machine, by a multitude of inventors and patentees, not one of whom, however, could or would have made the pioneer machine if Howe had never lived. These subsequent inventions were of all degrees of novelty and were produced by the exercise of most all degrees of invention, excepting only, that none of them was or could be the pioneer inventor of a mechanical sewing-machine. Howe was the first to make that and there *never can be but one first* in anything. We treated more at length on this subject in our brief filed herein, pages 29 to 46. Howe's patent was of course given a very liberal construction but still it was never made to cover anything except his invention. But his invention was so broad, consisting of the entire machine, and every part and parcel of it, that the various mechanical equivalents that were adopted by other manufacturers who subsequently made sewing-machines came within Howe's invention, and were covered by his patent. Howe, no more than others, was ever allowed to spread his patent so as to make it cover the inventions of others, or to cover anything except what was included within his own discovery and invention.

Without undertaking to trace the different degrees of inventions that were made by the multitude of inventors in sewing-machines, who followed after Howe, we will come down to Cramer's patent as an illustration of an invention which was not to be allowed a liberal construction and therefore not allowed to cover mechanical equivalents of the particular devices which he used.

In Cramer's invention there was not a single new or novel mechanical action of any part of the moving machinery. He used only the sewing parts of the sewing-machine that were made by others. He used only the same kind of a treadle and pitman to connect his treadle with the sewing part of the machine that had already been in use by others from whom in fact he obtained them. There was therefore nothing of any new mode of operation that was invented or discovered by him. His was not a case in which the Supreme Court allowed the patent to cover mechanical equivalents. While the Supreme Court did not say this in so many words, it did in effect, as it did not allow the patent to cover what was claimed by Cramer's counsel to be the mechanical equivalent of the knife-edge bars, etc., named in the claim as a part of its combination.

Now to what extent ought a patentee to be allowed to cover mechanical equivalents in combination claims? We assert that the extent and limit to which the combination claims may be allowed to cover mechanical equivalents is measured by the extent and limit to which that combination *has produced a new mode of mechanical action or mechanical operation*, whether that be more or less. In a combination which has made but very little change in the mode of mechanical operation the range of mechanical equivalents which the claims may cover would be very narrow, while in the combinations that are more productive of results in producing or changing or modifying mechanical actions, the range of mechanical equivalents which will be covered, when put in place of any omitted



devices of the combination, will be correspondingly increased.

We believe that this rule is the one which is produced by the boiling down of the great mass of adjudications made by the Supreme and other U. S. Courts, and that it is a just and correct one. If so, by following the rule in most cases, the constructions of the claims and the proper extent to which they may be made to cover mechanical equivalents is comparatively easy.

We have complained and do now complain that the U. S. courts here have given to narrow patents the same broad construction, and have allowed narrow claims to cover mechanical equivalents to the same extent that it has allowed broad claims for broad inventions to do the same thing. It was admitted by the Circuit Court that the Cramer patent was a very thin patent, yet it allowed the claim to cover mechanical equivalents to the fullest extent that it was possible to go by giving the claim the broadest construction that possibly could be given to it.

This Court also gave the patent a very broad construction and allowed it to reach out and cover the later Diehl invention, no part of which had ever been made by Cramer.

There are a line of cases which the U. S. Supreme Court has made applicable to very broad inventions—among them are the cases of *Winans vs. Denmead*, 15 Howard 330; *Ives vs. Hamilton*, 15 How. 330. These cases are authorities on broad inventions and patents especially. But this Court, in deciding the Cramer case, cited as applicable thereto those same cases with some

others of the same nature as pertinent authorities, by which to construe the Cramer invention and patent. See the Singer case, page 655 of 109 Fed. Rep. where the said authorities are quoted by this Court. There is a very large number of other cases decided by the Supreme Court *applicable to narrow inventions and patents* which we seldom see cited by the courts here.

Among them are:

*Rowell vs. Lindsay*, 113 U. S. 97;

*Wicke vs. Ostrum*, 103 U. S. 461;

*Blake vs. San Francisco*, 113 U. S. 679;

*McMurray vs. Mallory*, 111 U. S. 97;

*Electric Signal Co. vs. Hall Signal Co.*, 114 U. S. 87.

See page 96 and cases cited by the Supreme Court on page 98.

*Dryfoos vs. Wiese*, 124 U. S. 32, last half page 37 and first half page 38;

*Weatherhead vs. Coupe*, 147 U. S. 322;

*Werner vs. King*, 96 U. S. 218;

and very many others in which the Supreme Court has protected the rights of defendants in patent cases.

Sometimes, however, this Court, and also the Circuit Court, here has cited such cases. Some of them were cited by this Court in the case of *Norton vs. Jensen*, 90 Fed. 415, on page 429. In fact, on said page 429 there is pure law and authorities enough declared and cited by this Court to win the case at bar for the defendants sev-

eral times over, if the Court would only apply that law and those authorities to the case. Also in the case of *Wheaton vs. Norton*, 70 Fed. 833, on pages 841 and 842, this Court cites and applies to the facts of the case, the law and authorities, which we claim ought to be applied in this case, and we cannot understand why the Court does not so apply them.

When the case of the *Singer Mfg. Co.*, plaintiffs in error, vs. *Herman Cramer*, defendant in error, was before this high tribunal Wheaton & Kalloch filed a brief for the Singer Co. Now that we have the Supreme Court upon our side of these questions which we discussed at considerable length in that brief we will quote the following from pages 89 to 103 thereof, as follows:

“The Court understands that there are innumerable cases in which the Supreme and other Courts have held that the rule of equivalents could not apply. Among the cases in which the rule does not apply are those in which the invention is very narrow, and in which no new mechanical principle or new mode of operation is developed.

Curtis on Patents, Sec. 455, defines the character of inventions in which the patentee may claim other forms of his invention than the one contained in his patent. In speaking of construing a patent Curtis says: “Or his invention may be so stated as to render it doubtful  
 “WHETHER HE HAS INVENTED OR DISCOVERED THE GENERAL APPLICATION OF A  
 “PRINCIPLE TO PRODUCE A PARTICULAR EFFECT, AND IS THEREFORE ENTITLED TO  
 “CLAIM ALL THE FORMS IN WHICH THE SAME

“PRINCIPLE CAN BE APPLIED TO PRODUCE  
 “THE SAME EFFECT, OR, WHETHER HE HAS  
 “ONLY INVENTED OR DISCOVERED A FORM OF  
 “GIVING EFFECT TO A PRINCIPLE THE APPLI-  
 “CATION OF WHICH WAS KNOWN BEFORE.”

In Sec. 456, and those following, Mr. Curtis has stated the rules as to what constitutes a broad invention and what constitutes a narrow invention, and they amount to this: So far as the inventor has invented or discovered a new principle, or what is the same thing, a new mode of operation, he can claim that new principle, or new mode of operation. But in so far as he has only used a principle that has already been known and applied, then he has only invented a new mode of applying that principle or mode of operation, and his patent will be limited to that new mode which he has discovered or invented. Discovery and invention mean the same thing in cases of this kind. Walker on Patents, Sec. 2.

Any number of authorities might be cited, and we have cited many of them in other cases before this Court, tending to repeat these rules here cited from Curtis. It would seem that their evident justice and compliance with the law that provides for granting patents would commend them to the judgment of any Court. These rules give to each inventor just what he has invented, and that is what the law provides for, and it is just what an inventor is entitled to in common honesty. But these rules do not take from other later inventors what they have invented, and give all of the inventions to one who happens to be the plaintiff in an infringement suit.

Now the only way that we know of that has ever been used by the courts, by means of which an inventor of a new principle is protected in the use of that principle, is by the application of the rules of equivalents. If he has described his invention, and shown means by which it may be applied in one form, he is protected when his invention is appropriated by other means which are substantially the same. But he is not protected in the result that he produces. His patent covers only the means by which he has applied his principle, and such analogous means as are the mechanical equivalents of those specific means which he has shown. Usually when an inventor has made an entirely new discovery like the telephone or telegraph, his invention is very broad and covers the machine as a whole; and in such cases he will be protected against any other machine which operates on the same principle, even if other mechanisms are used. Such are cases where a patent covers the entire machine, which is so entirely new that it produces for the first time in the world not only a new result, but a new kind of result that was never before known and never before produced. Compare, or rather contrast, the depth of discovery and the invention of means by which the speaking telephone was brought into the light of the world with the mere changing of the hanging of a well-known treadle in the well-known and "usual" vertical double brace instead of in the web of the legs of a well-known stand of a well-known sewing machine. Compare this mere changing of the place in the hanging of the well-known bearings of a sewing-machine treadle with the invention of Fulton, who astonished the world by applying for the first time

in the world steam to a floating vessel and driving it up stream against the river's current. Compare it with the invention and discovery of Morse, who for the first time in the world applied electricity to the producing of an intelligible alphabet and established the instantaneous communication thereof between persons situated at great distances apart.

While making these comparisons, and noticing the contrasts between Mr. Cramer's alleged invention and those great discoveries, we ask the Court to realize that the Circuit Court HAS GIVEN TO MR. CRAMER'S PATENT AND INVENTION AS BROAD A CONSTRUCTION AS IT COULD HAVE GIVEN TO MORSE'S PATENT, OR TO FULTON'S PATENT, OR TO BELL'S TELEPHONE PATENT, IF THOSE PATENTS HAD COME BEFORE IT FOR ADJUDICATION. The Court gave to Cramer the entire result that might flow from hanging the treadle in or from the cross brace. It gave to him all the means through and by which the treadle could be supported not only in the brace, but all means by which it might be indirectly supported from the brace; it allowed him to take out from the claim of his patent the trunnions with their knife-edges, and construe the patent to be for attaching the treadle to the brace indirectly by means of intervening point centers. Cramer was allowed full latitude to take out of his claim, not only the trunnions, but also its knife edges and the holes through the lower extremities of the brace to serve as bearings, and also the knife-edge and every other kind of bearings fitted or unfitted to oscillate

in those bearings or in any bearings that were in holes provided in the lower extremities of the brace. No broader construction, and no greater range of proofs, was ever given, or could be given, to the Fulton patent, or to the Morse patent, or to the telephone patent.

From all this it seems to us that this Court must see and feel that a great error has been committed by the Circuit Court that ought to be corrected.

We remind the Court that the *only effect of a broad construction* in any machine patent is that it allows a greater range in proving the application of mechanical equivalents of the devices described in the patent sued upon. A narrow construction does not allow the proof of mechanical equivalents to the same extent as does the allowance of a broad construction. If a plaintiff is allowed to prove the use of mechanical equivalents on the part of a defendant, and thereby work out an infringement, it is because the Court gives to the patent sued upon a broad construction.

Now a broad, or a narrow, or a medium construction should be given to a patent according to the actual scope of the invention. The authorities that sustain this proposition are legion, and they are concentrated by Curtis in the language above quoted from him.

In Walker on Patents, from Sec. 359 to Sec. 362, the author cites three cases of the Supreme Court upon the application of the rule stated. The three cases are :

*McCormick vs. Talcott*, 20 How. 405;

*Railway Co. vs. Sayles*, 97 U. S. 556;

*Morley Machine Co. vs. Lancaster*, 129 U. S. 273.

The author quotes from the first of these cases the following:

“If the patentee be the original inventor of the device  
 “or machine called the divider, he will have a right to  
 “treat as infringers all who make dividers operating on  
 “the same principle, and performing the same functions  
 “by analogous means or equivalent combinations, even  
 “though the infringing machine may be an improvement  
 “of the original, and patentable as such. But if the in-  
 “vention claimed be itself *but an improvement on a*  
 “*known machine by a mere change of form or combina-*  
 “*tion of parts*, the patentee cannot treat another as an  
 “infringer who has *improved the original machine by use*  
 “*of a different form or combination performing the same*  
 “*functions*. The inventor of the first improvement can-  
 “not invoke the doctrine of equivalents to suppress all  
 “other improvements, which are not mere colorable in-  
 “vasions of the first.”

He quotes from the second of these cases the following:

“In such cases, if one inventor precedes all the rest,  
 “and strikes out something which *includes and underlies*  
 “*all that they produce*, he acquires a monopoly, and sub-  
 “jects them to tribute. But if the advance toward the  
 “thing desired is gradual, and proceeds step by step, so  
 “*that no one can claim the complete whole, then each is*  
 “*entitled only to the specific form of device which he*  
 “*produces*, and every other inventor is entitled to his



“own specific form, so long as it differs from those of his competitors, and does not include theirs.”

And from the third of these cases as follows :

“Where an invention is one of a primary character, and the mechanical functions performed by the machine, *are, as a whole, entirely new*, all subsequent machines which employ *substantially the same means* to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine.” The author adds: “And the Court also said that secondary patents ought to receive a narrower construction than this.”

The rule is stated by the United States Supreme Court, perhaps as plainly as it could be stated, in the case of *Miller vs. Eagle Mfg. Co.*, 151 U. S., on page 207, as follows :

“The range of equivalents depends upon the extent and nature of the invention. *If the invention is broad or primary in its character, the range of equivalents will be correspondingly broad*, under the liberal construction which the courts give to such inventions. The doctrine is well stated in *Morley Machine Co. vs. Lancaster*, 129 U. S. 263, 273, where it is said ‘Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, ENTIRELY NEW, all subsequent machines which employ *substantially the same means to accomplish the same result* are infringements, although the subsequent

“ ‘machine may contain improvements in the separate  
 “ ‘mechanisms which go to make up the machine.’ ”

The Supreme Court adds on the same and the next pages:

“ Tested by this rule, and in view of the prior devices  
 “ and the great variety of springs in use previous to the  
 “ granting of his patent, Wright cannot be treated as a  
 “ pioneer in the art. *Neither can he, nor his assignee, be*  
 “ *allowed to invoke the doctrine of equivalents, such as*  
 “ the courts extend to primary inventions, so as to include  
 “ all forms of spring devices and adjustments which  
 “ operate to perform the same function, or accomplish  
 “ the same result.”

“ Again, the issuance of the patents to Gardiner &  
 “ Downey, Berlew & Kissell, and Elder creates a *prima*  
 “ *facie* presumption of a patentable difference from that  
 “ of the Wright patent of 1879.” *Corning vs. Burden*, 15  
 How. 252; *Duff vs. Sterling Pump Company*, 107 U. S.  
 636.

“ We think it manifest, from the prior state of the art,  
 “ if the invention covered by his patent of 1879 was not  
 “ anticipated, and if it has any validity, that it must be  
 “ *limited and confined to the specific spring device which*  
 “ *is described in the specification and shown in the draw-*  
 “ *ings forming parts of the letters patent. Being thus*  
 “ limited, there is clearly no infringement in the device  
 “ used by the appellants or their principals, P. P. Mast  
 “ & Company.”

The evident justice of this rule is apparent to every intelligent mind. It gives to the inventor just what he has invented, no more and no less. This is what the law says he may have, viz: A PATENT FOR WHAT HE HAS INVENTED. Sec. 4886 Revised Statutes.

The cases in which the rule has been applied and a narrow construction given to a patent that covered only a narrow invention, and thereby narrowed the range of mechanical equivalents applicable, are too numerous to mention. The following are some of them:

*Lehigh Valley Railroad Co. vs. Kearney*, 158 U. S. 461, latter part page 476.

*Jeffrey Mfg Co. vs. Independent Electric Co.*, 83 Fed. 191, page 201, and cases there cited.

*Illinois Steel Co. vs. Kilmer Mfg. Co.*, 70 Fed. 1012, latter part page 1016.

*Campbell Printing Press Co. vs. Duplex Printing Press Co.*, 86 Fed. 315, page 323, also latter part of page 326 and page 327.

*Boyd vs. Janesville Hay Tool Co.*, 158 U. S. 260, first half of page 267.

*St. Louis Car-Coupler Co. vs. Malleable Castings Co.*, 81 Fed. 706, page 724, and authorities there cited.

*Phoenix Castér Co. vs. Spiegel*, 133 U. S. 360, beginning near bottom of page 368.

*Wells vs. Curtis*, 66 Fed. 318, last paragraph page 324, page 325.

*Noonan vs. Chester Park Athletic Club Co.*, 99 Fed. 90, page 93.

“ ‘machine may contain improvements in the separate  
 “ ‘mechanisms which go to make up the machine.’ ”

The Supreme Court adds on the same and the next pages :

“ Tested by this rule, and in view of the prior devices  
 “ and the great variety of springs in use previous to the  
 “ granting of his patent, Wright cannot be treated as a  
 “ pioneer in the art. *Neither can he, nor his assignee, be*  
 “ *allowed to invoke the doctrine of equivalents, such as*  
 “ the courts extend to primary inventions, so as to include  
 “ all forms of spring devices and adjustments which  
 “ operate to perform the same function, or accomplish  
 “ the same result.”

“ Again, the issuance of the patents to Gardiner &  
 “ Downey, Berlew & Kissell, and Elder creates a *prima*  
 “ *facie* presumption of a patentable difference from that  
 “ of the Wright patent of 1879.” *Corning vs. Burden*, 15  
 How. 252; *Duff vs. Sterling Pump Company*, 107 U. S.  
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“ We think it manifest, from the prior state of the art,  
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*Phoenix Caster Co. vs. Spiegel*, 133 U. S. 360, beginning near bottom of page 368.

*Wells vs. Curtis*, 66 Fed. 318, last paragraph page 324, page 325.

*Noonan vs. Chester Park Athletic Club Co.*, 99 Fed. 90, page 93.

*St. Louis Car-Coupler Co. vs. National Malleable Co.*, 87 Fed. 885, pages 900 and 901.

*Ney vs. Ney Mfg. Co.*, 69 Fed. 405.

*Fay vs. Cordesman*, 109 U. S. 408, pages 416 and 417.

*Yale Lock Co. vs. Sargent*, 117 U. S. 373, last paragraph on page 378.

*Craig vs. Michigan Lubricator Co.*, 72 Fed. 173, pages 176, 177, 178.

*Penfield vs. Chambers Bros. Co.*, 92 Fed. 630.

*Duff vs. Pump Co.*, 107 U. S. 636.

*Snow vs. Railway Co.*, 121 U. S. 617.

*Carter Co. vs. Hanes*, 70 Fed. 859.

*New Departure Co. vs. Hardware Co.*, 69 Fed. 154.

*Engle Co. vs. City of Elwood*, 73 Fed. 486.

*King Co. vs. Hubbard*, 97 Fed. 795.

In *Jensen Can-Filling Machine Co. vs. Norton*, 67 Fed. 236, on page 239 this Court defines a mechanical equivalent in the following language :

“Mechanical equivalents, as that phrase is to be understood in this connection, are such devices as were known previously, and which in the particular combination of devices specified as constituting the patented invention, can be adapted to perform the functions of those specified devices for which they are employed as substitutes, without changing the inventor’s idea of means.”

Since the trunnions of the Cramer patent performed the one office of filling up the space between the edge of the foot piece of the treadle and the bearings in the brace so as to connect the oscillating bearings in the brace with

the edge of the foot piece of the treadle, in order that the foot piece should be supported by those bearings, and also in order that the oscillation of the foot piece should operate to oscillate the bearings, and as the point center bolt did not perform either one of these functions, it could not be a mechanical equivalent of the trunnions. The point center bolts were not “adapted to perform the functions” of those trunnions and could not have been any equivalents of them.

The foregoing list of cases might be extended to a very great length. While the very broadest construction is given to original pioneer inventions, such inventions are now so very few in number that there are few opportunities for such application of the rule in practice. Howe’s original sewing machine, Morse’s telegraph, Fulton’s first steamboat and Bell’s telephone are among the inventions which the courts have pronounced to be pioneer inventions. Improvements on such pioneer inventions have been produced by thousands. As the Supreme Court says in *Machine Co. vs. Lancaster*, 129 U. S. 263, page 273, and in *Miller vs. Eagle Manufacturing Co.*, 151 U. S., page 207:

“Where an invention is one of a primary character, “and THE MECHANICAL FUNCTIONS PERFORMED BY THE MACHINE ARE AS, A WHOLE, “ENTIRELY NEW, all subsequent machines,” etc. To be a pioneer invention the functions performed by the machine *must as a whole be entirely new*. Those functions must never have been performed before by any ma-

chine, otherwise that prior machine, and not the later, is the pioneer machine.

These rules, established by the cited authorities, give to an inventor all that he has invented and obtained his patent for. This is all that in common justice and honesty can belong to him. If he has invented a machine which for the first time in the world has produced useful results that had never been produced before, he has developed a new principle, a new mode of operation, and the law protects him in it by allowing him to invoke to the fullest extent the doctrine of mechanical equivalents, and to shut off others who, after learning of his machine, and finding out the new results obtained by it, and its new mode of operation, undertake to appropriate to themselves that new result and mode of operation by embodying them in another machine, constructed on the same principle and embodying the same mode of operation and producing the same results. But if that inventor himself had seen prior machines producing those same results, and had himself made a new machine which produced those old results by new mechanism operating in substantially the same way, he is not a pioneer inventor, although his mechanism may be new as he has applied it. He is using what he obtained from the prior knowledge of others. Is it not plain that it is the discoverer of the original principle, who has produced it for the first time, that is entitled to cover, by applying the doctrine of mechanical equivalents, all subsequent machines which adopt that same mode of operation and thereby produce a repetition of the same new results? And is it not equally



plain that so long as those equivalents belong to the first inventor they cannot in the nature of things also belong to the second party who has built the second machine, although he has made it with new mechanism, which we may concede he has invented? *Both cannot be the owners of the same principle or mode of operation of the machine. Both did not invent or discover it.* Both cannot therefore be the owners of the mechanical equivalents which third parties may use in building a third machine, with still newer machinery, but which embodies the same old mode of operation and produces the same old result that was new with the first inventor.

To illustrate a little farther; suppose, as is often the case, that the builder of the second machine makes a valuable and patentable improvement on the first pioneer machine. To some extent he has in such case produced a new mode of operation by his new mechanism. To some extent he has put into the machine something of value which the pioneer inventor did not put into the pioneer machine. In such case, as to the *additional* new mode of operation, the builder of the second machine becomes a pioneer and may call to his aid the doctrine of mechanical equivalents to protect his invention, *but only to the extent that he has developed and produced a new result, and a new mode of operation.* But he cannot go back and appropriate to himself any part of the pioneer invention *nor any part of the mechanical equivalents that belong to it.* His rights cannot begin until those of the pioneer are passed, and his ownership can only begin where the rights and ownership of the pioneer ended. The owner-

ship of the mechanical equivalents of that pioneer mechanism belonged to the pioneer inventor until his patent expired, and then those mechanical equivalents belong to the public.

*Smith vs. Nichols*, 21 Wall. 112, pages 118 and 119.

It is usual, after an original machine of great value has been produced and gone into general and extensive use, for subsequent inventors to make an almost unlimited number of so-called improvements on that machine, and to go still further and make and patent changes and additions which are not improvements but are only changes for the worse. Such changes have no value, because no users of the machine want them, nor will they have them. They commonly involve no invention, but are made in attempts to appropriate a valuable machine, although that machine belongs to the original inventor; or, if his patent has expired, it belongs to the public.

Applying the state of the art and the rules of construction to the Cramer patent, we find beyond any question that it is not only not a primary invention, but it is one of the very narrowest, if it is any invention at all. There is not contained in it a single shade of a shadow of new movement in any of its parts. Its knife-edge bearings, rocking in their underneath bearings, were in the Wilcox & Gibbs, as were also the pitman and band wheel.

Not only was there no *new* motion obtained by Cramer, but there was not the remotest shade of a shadow of *difference* in motion produced by Cramer. The

knife-edges, the treadle with its trunnion arms, the underneath bearings in which the knife-edge bearings rested and oscillated, the treadle and band wheel, all from beginning to end acted just as the same devices, whether taken singly or collectively, individually or in combination, had acted in the Wilcox & Gibbs. The Cramer patent as to its first claim is as narrow a patent as ever issued from the patent office. There can be no reasonable doubt of this fact. There can therefore be no "range of equivalents" in this case. Since there was no new motion of any kind in any one of the devices used, nor in the combination of devices as a whole, there could not be and was not any new mode of operation produced whatever, no new mechanical principle was developed. There could be no mechanical equivalents of what was contained in the Cramer *except what were mechanical equivalents of, and belonged to, the owners of the Wilcox & Gibbs*; and as the Wilcox & Gibbs patent has now expired, those mechanical equivalents have become the property of the public."

We have quoted the foregoing from our former brief in the Cramer case, both because we deem it a pertinent argument to use in this petition, and also because it shows how faithful we have been in following the decisions of the Supreme Court, and the provisions of the patent law as those provisions have been interpreted and administered by the adjudications of the Supreme Court. This conspicuously appears by taking what we have above quoted from our said former brief and comparing it with the said late decision of the Supreme Court in the same Cramer case.

The real questions are as to who invented the Letson & Burpee machine, and who has the patent on it? Was it Jensen, or was it Letson & Burpee? The date on their patent shows that Letson and Burpee did not apply for their patent until 1893. Jensen is a native of Europe, and for many years last past he has been in Europe and is there yet. It is safe to say that he has never yet even seen one of the Letson & Burpee machines. How could he be an inventor of a machine which was made by others, which he had no hand in making, had not even known anything of it until long after it was made and completed by Letson and Burpee, and which he has never even seen? We cannot believe that Jensen invented the Letson & Burpee machine, and we all know that his patent does not describe it, and we know equally well that the claims of his patent do not include the Letson & Burpee machine, nor do we believe that they cover any part of it

The Letson & Burpee machine is a new machine not made until eleven years after the Jensen patent was issued. It is confessedly a much better machine than the Jensen. It is much more valuable. If Jensen invented it he must have known of it. If he knew of it, or if any one knew of it, why did it remain unknown to the world for eleven long years? Why was it not made and put into use?

In the defendant's machine there are two vertical rotating spindles, each one of which carries two skeleton wheels, which are rigidly attached to, and rotate with it. These two spindles and the two wheels which each of

them carry are foundation mechanical elements in the machine. They are its main moving parts. Are those two spindles and their four skeleton wheels Jensen's invention? Whereabouts in the Jensen machine are those spindles found? Whereabouts in the Jensen machine are those wheels, or either one of them found? Those skeleton wheels are made up in part by the pockets which take the can bodies from off the belts and drive them around on the rotating plungers.

Really, all that is necessary for this Court to do in order to construe the patents and decide upon the question of infringement, is to compare the specifications and drawings of the Jensen patent with the specifications and drawings of the defendants' patent. In the Cramer case, as in this case, the defendant's machine was described in a patent covering a later invention, the Diehl invention in the one case and the Letson & Burpee invention in the present case. As the Supreme Court says in the Cramer case,

“As in each of the patents in question it is apparent  
 “from the face of the instrument that extrinsic evidence  
 “is not needed to explain terms of art therein, or to ap-  
 “ply the descriptions to the subject-matter, and as we are  
 “able from mere comparison to comprehend what are the  
 “inventions described in each patent and from such com-  
 “parison to determine whether or not the Diehl device is  
 “an infringement upon that of Cramer, the question of  
 “infringement or no infringement is one of law and sus-  
 “ceptible of determination on this writ of error. (*Heald*

“vs. *Rice*, 104 U. S. 737; *Market Street Cable R. Co. vs. Rowley*, 155 U. S. 621, 625.)”

A comparison of the two patents, whether made with or without whatever light may be thrown upon the comparison by the use of the testimony in the case, makes it evident that the two machines are entirely different in their construction, in their mode of operation, in the devices of which they are composed, and in the sub-combinations of those devices. The defendants' machine is a continuously operating machine while the Jensen machine is an intermittent machine only. This difference in the mode of operation of the two machines compelled the defendants to make an entirely new plan for their machine. It was a new plan *of operation* and compelled a new plan of *construction* and new kinds of operating devices all the way through. The *novelty goes all through the defendants' machine*, and the plan of it. It is not an added improvement to the Jensen machine. If the defendants' machine was an improvement upon the Jensen machine there would of course be some place in the defendants' machine where the Jensen machine would stop, and the defendants' improvements on the Jensen machine would commence. But no such place can be found. No such place has been found either by the counsel or by the Court. On pages 185-186 and 187 of the appellee's brief, counsel assert that the claims in controversy do not purport to cover the defendants' machine as a whole. That those claims are for sub-combinations only. But on page 187 of their brief counsel assert that claim 16 of the Jensen patent is a claim for the entire machine, and

that that claim specifies the machine as *intermittently operating*.

This statement, with the fact that there has been no assertion that claim 16 of the Jensen patent was infringed by the defendants' machine, constitutes a direct admission that the continuously operating machine of the defendants, taken as a whole, is no infringement of the Jensen patent, wherein is covered the intermittently operating machine as a whole.

This admission is undoubtedly correct but this distinction between a continuously operating mechanism and an intermittently operating mechanism *runs all through the two machines*. It is first incorporated in the plans of the machines as entire machines. Also in the construction of the machines as entire machines. It is equally certain that all the material sub-combinations of the machines develop the same distinctions and differences. But more of this hereafter.

On said page 187 of appellee's brief referring to Jensen's patent, it says: "But when he claimed the various sub-combinations, he did not limit them to any particular kind of a machine, because they could be used in many kinds of machines."

If by the last few words it was intended to assert that the sub-combinations of the Jensen machine could be used in a continuously operating machine the same would be absolutely incorrect. *The mechanical sub-combinations of the Jensen machine can not be used in a continuously working can capping machine*. It would be as impossible

as the construction of a perpetual motion machine. It is an utter physical impossibility to operate any material sub-combination of mechanism that is used in the Jensen machine in any kind of a continuously operating machine.

Probably the worst feature, however, of the above quotation from appellee's brief is that part wherein it is asserted that Jensen, in his claim of the various sub-combinations, did not limit them to any particular kind of a machine, etc. The pretense that an inventor may extend his claims so as to reach out and cover what he has never invented by simply saying that he does not limit himself, is a slander of the patent law. The patent law allows no patentee to claim anything that he has not invented or anything that he has not described in his specification and drawings. How would a claim of this kind read?

“I do not limit myself to my invention as I have described it herein as other machines may be invented hereafter by other parties by means of which filled fish cans may be headed automatically, and as in such machines the effect of heading filled fish cans will be accomplished, I therefore claim all machines by whomsoever hereafter invented that will accomplish the effect of automatically heading filled fish cans.”

Of course such a claim could never get past a demurrer in any court, yet counsel is practically claiming that his claims be given an interpretation that would fairly come within the foregoing language, and they expect to have the Court give the claims such construction and have them reach over and cover the defendants' machine accordingly.



We respectfully ask the Court to review its decision rendered herein and see if it has not come dangerously near to making just such a decision as appellee's counsel are claiming. We assert with all the emphasis which we can throw into the assertion that a patentee cannot extend in his patent specification, or afterwards in the courts, that he has not limited himself to what he has described his patent claims beyond his invention by stating either in his specifications.

We now return to a comparison of the two machines, the Jensen and the defendants. On pages 99 and 100 of our brief on file herein, we cited Sec. 256 of Robinson on Patents, in which the rule is laid down *that new and subsequent inventions cannot be any infringement* of an earlier patent. There are many authorities, including decisions of the U. S. Supreme Court, and also including the decision of this Court in the case of *Ransome vs. Hyde*, 69 Fed. 148, which holds that a defendant's patent is evidence for him just as much as a plaintiff's patent is evidence for the plaintiff. The defendants' patent has twenty-one claims. Claims 1 and 2 cover their machine as an entire machine. The subsequent claims go through their machine and cover the several sub-combinations and devices of which it is composed. Nothing of their machine seems to be missed from their claims.

In the defendants' machine there are two vertical rotating spindles, each one of which carries two skeleton wheels. These two spindles and the two wheels which each of them carry are foundation mechanical elements of the machine. They are its main moving parts. Now

we ask, are those spindles, which are necessary to the defendants' machine, found in the Jensen patent or not? If they are not they are certainly no part of Jensen's patented invention.

What is there in the Jensen machine of which those spindles or either of them is a mechanical equivalent? Of course there is nothing. Who then invented the spindles and first put them in a can capping machine? Was it Jensen or was it the defendants? Have not the defendants the patent covering those spindles as a part of their machine? Did Jensen ever have any patent that covered those spindles in any way, shape or manner as a part of his invention? It will not be pretended that he ever did.

Who invented the rotating skeleton wheels that are mounted upon the said spindles and which revolve with them and embodied those wheels in a can capping machine? Was it Jensen or was it the defendants?

Who has a patent for the incorporation of those rotating skeleton wheels into the can capping machine? Did Jensen get such patent or did the defendants get it? It will not be pretended that Jensen ever made such an invention or ever obtained such a patent for it, or that defendants did not make the invention, and they certainly have a patent for it.

Next, who invented the pockets and placed them in each corner of said rotating wheels in such connection with other devices that they were operative for the first time in a can capping machine? Did Jensen invent such

pockets or combine them with such rotating wheels, or was it the defendants, Letson & Burpee, who invented those pockets and placed them in the rotating wheels, and thus, for the first time in the world, utilized them as devices incorporated into a can capping machine? Was this the invention of Jensen or was it the invention of the defendants, and who obtained a patent for those inventions? Was it Jensen or was it the defendants? It must be admitted that this invention was made by the defendants, was never made by Jensen, and that defendants have a patent which covers the invention, and the plaintiff has not any such patent.

Next, who invented the rotating moving plungers of the defendants' machine, and for the first time in the world placed them as operative devices in a can capping machine, and placed them in a machine in combination with other devices which made them operative in can capping machines? Was it Jensen that did this, or was it the defendants who did it, eleven years after Jensen had reached his limit in inventing improvements in can capping machines? Of course it was the defendants who made these inventions, and it is the defendants who have a patent for them. Are these moving plungers described in Jensen's patent or covered by any of his claims? They certainly are not. It was not Jensen's invention, but it was the defendants' invention, and the defendants have their patent for it, properly granted to them.

Jensen had reached the end of his inventions in can capping machines *eleven years before any part of the de-*

*defendants' machine was produced.* When Jensen ceased work on can capping machines, he had not made, or attempted to make, any continuously operating machine. He never did attempt to use traveling plungers, nor to so plan a machine that traveling plungers could be used in it. He had never used or attempted to use the spindles, such as defendants use, nor the skeleton wheels which those spindles carry, nor the pockets which are carried by, and operate in combination with, those wheels and spindles, nor, in short, any of those things which are described in and covered by the claims of the defendants' patent. All those things were eleven years behind the date at which Jensen quit the field of invention. All of them were to remain eleven years longer unknown, and they did remain eleven years longer unknown, and until the defendants brought them to light, and to the knowledge of the world.

All this being so, *indisputably*, by what right are they, or any of them taken from the defendants' patent and given to the Jensen patent? It is incomprehensible to us. We cannot understand it.

### CLAIMS THREE AND ELEVEN OF THE JENSEN MACHINE.

We make a special appeal to the Court to reconsider its ruling with reference to Claims 3 and 11. His Honor, Judge Hanford, decided that the defendants' machine did not infringe either one of these claims for the reason that the claims were combination claims and that the feeder F was one of the mechanical elements of each of the com-

binations, and that such feeder F was not in defendants' machine at all. As is well known, Judge Hanford is a gentleman who possesses mechanical faculties of an unusually high order, and who reads naturally and correctly the movements, actions and operations of any machine that he may observe when it is at work. He has, as we understand, himself invented a very ingenious machine especially designed for the heading of filled fish cans. The fact that Judge Hanford could not find the feeder F of the Jensen patent in the defendants' machine is certainly very strong proof that it is not there. The action and the operation of the feeder F in the Jensen machine is very fairly described by this Court in its decision herein rendered. The feeder F is a straight back with four arms projecting at right angles, forming three pockets. It is attached to three vertical cranks which rotate, giving the feeder an eccentric sweeping motion. The feeder F in this sweeping movement catches the can in the first pocket between the first pair of arms and, pushing it at right angles to the line of the belt travel, moves it a short distance and then recedes, leaving the can stationary till the next sweep, when it is received into the middle pocket and moved upon the plunger S. The Jensen feeder F is carried upon cranks so arranged as to give the feeder an eccentric sweeping horizontal motion, and *this motion is absolutely necessary* to create the intermittent motion by which the cans are moved forward through the machine. Without that *intermittent*, horizontal, eccentric sweeping motion the Jensen machine would not head any cans and would not perform any successful operation whatever. Said claim 3 is as follows:

“In combination with a transverse belt the feeder having the projecting arms between which the cans are received from the belt and the actuating devices by which the motions of the feeder are produced, substantially as herein described.”

Now this claim is clearly a combination claim. Its elements being a transverse belt, the feeder F having the *straight back*, and the projecting arms H, *between which* the cans are received from the belt and the *actuating devices by which the motions of the feeder are produced*.

Now what are the motions of the feeder which are produced by the actuating devices? They are of course the said *eccentric sweeping* motions by means of which the cans are moved *intermittently* forward. The claim therefore calls for *actuating devices by which these eccentric sweeping motions of the feeder are produced*. Those actuating devices constitute *one of the mechanical elements of the combination* of claim 3.

Now are there any such actuating devices in the defendants' machine? We do not think that this Court or any judge of this Court would think for a moment of asserting that there were any actuating devices in the defendants' machine that would produce the eccentric sweeping motion of the feeder F.

This mechanical element, the actuating devices for producing the *motions of the feeder* seems not to be taken into consideration by this Court at all in passing upon the issue of infringement of said claim 3, although those actuating devices are one of the mechanical elements of said claim 3. The Court in its opinion says:

“The question is, do the appellants use a feeder with projecting arms between which the cans are received from the belt? It is apparent at a glance that the periph-  
 eric wheel could be constructed as well with projecting arms as with the curved pockets and that its operation would not be altered. If the appellee is entitled to be protected in the claim as it is made in his patent, and it is not disputed that he is entitled to such protection, we think infringement cannot be avoided by merely changing the shape of the arms of the feeder. Nor do we think that the fact that the wheel 36 of the appellants’ machine moves in a true circle, while the feeder of the appellee’s moves eccentrically and intermittently sufficient to constitute a fundamental difference.”

Now in this the Court leaves entirely out of consideration the fact that these actuating devices constitute an element of the combination, and the decision actually holds in effect, that a combination claim is infringed when one of the necessary indispensable mechanical elements of the combination has not been used by the defendants. Must we be denied the benefit of that rule of patent law which says that a combination claim cannot be infringed unless every one of the mechanical elements that are included by the claim in its combination has been used by the defendants? What have we done that so elemental and universal a rule should be refused to us, though allowed to every one else? Are these defendants outlaws, or what is the trouble? We believe that a great wrong has been done us in this respect by denying to us the benefit of this rule of law and we now come and respectfully ask the Court to right that wrong.

And in the consideration of this portion of its decision we ask the Court to notice particularly that what said claim three calls for are actuating devices by which the *motions of the feeder F* are produced. It is not a claim for devices that will produce other motions which do not belong to the feeder F. The devices must produce the eccentric sweeping motions of the feeder, as those are the only motions which are given to the feeder. No matter what the form of the arms H of the feeder may be, the actuating devices must produce those eccentric sweeping motions which belong to, and must govern the feeder. The actuating devices of claim three are not to produce any true circular motions. Such motion would destroy the whole action of the Jensen machine.

If every member of this Honorable Court was to examine the defendants' machine through a Lick telescope, with its magnifying power increased a thousand fold, not one of them could find in the machine the shade of a shadow of those actuating devices which are an element of said claim three. Those actuating devices are not only not in the defendants' machine, but they could not be put into it, nor any equivalent of them, without destroying the entire action of the machine.

We now assert that those actuating devices are one of the mechanical elements of said claim three, and that there cannot be any infringement of said claim unless those actuating devices are used in the infringing machine, and we further assert that those actuating devices are not in the defendants' machine, and that therefore the combination that is covered by said claim is not used



in the defendants' machine, and the machine therefore is not, and cannot be any infringement of the said claim.

We are striving to so impress this fact upon the attention of the Court that it will not be overlooked or disregarded and passed over without notice. There is so much of argument made, and so many authorities cited in our brief herein filed which the Court has not noticed in its decision, that we trust to be excused for apprehending that the same thing might happen with points made in this petition unless such points are pressed somewhat upon the attention of the Court.

Now we do not believe that there is any pretense or belief on the part of any member of this Court that the *actuating devices which produce the eccentric sweeping motion* of the feeder F, which is *especially called for by said claim 3*, can be found in the defendants' machine. Not only is the feeder F not there but those actuating devices which give to the feeder F its motions are not there either. Not only are those actuating devices which produce the motions of the feeder F as called for by the claim not in the defendants' machine, but they could not be put into it without absolutely destroying its entire operation. It is shown overwhelmingly by the testimony that the feeder F is not in the defendants' machine and that it could not be put in the defendants' machine without destroying the machine. There is no one who understands the two machines but that knows this to be the fact. It is not a case of putting the feeder F in the defendants' machine merely changing the shape of its arms H, but it is a case where neither the feeder, *nor its*

*movements*, could be put into the defendants' machine without destroying the entire movements and mode of operation of the defendants' machine.

Judge Hanford was right when he decided that the feeder F was not in the defendants' machine. As the feeder F is a mechanical element in the claim eleven and as the feeder is not in the defendants' machine the decision of Judge Hanford with reference to claim three, and also claim eleven, ought to be sustained. Nor do we for a moment yield assent to the position taken by appellee's counsel, that it makes no difference that the Jensen patent covers the intermittent machine only, while the defendants' machine is not intermittent but is a continuous motion machine. By being made continuous motion the defendants' machine is a very much more effective and more valuable machine. It is only made continuous motion by leaving out of it almost every device utilized in the intermittent motion machine and using instead thereof an entirely different set of devices having different operations and movements and made up of a set of devices, most of which are new in can heading machines and which could not be used and were not used in any intermittently moving can heading machine. If it were possible to transfer the devices from one machine to the other without absolutely spoiling and destroying the machine it would be a different proposition. Let the Court go over the defendants' machine and undertake to pick out devices from it that could be put into the Jensen machine without destroying it, and it will find the number of such devices to be too small to be of any importance.

We desire to make this petition short and do not undertake to cover the whole case but to strike at enough that is vital to show that a rehearing ought to be granted. If a rehearing is granted we will make a farther presentation as to the other claims which Judge Hanford held were infringed.

Respectfully submitted,

M. A. WHEATON,  
of Counsel for Appellants.

We, the undersigned, counsel for petitioner, hereby certify that in our judgment the foregoing petition is well founded and that it is not interposed for delay.

M. A. WHEATON,  
I. M. KALLOCH.

